

## REMARKS

In the Office Action dated March 24, 2006, the Examiner issued a requirement for restriction under 35 U.S.C. §121 categorizing original Claims 1-28 as follows:

Group I: Claims 1-14, drawn to a lubricating oil composition, classified in class 508, subclass 485.

Group II: Claims 15-28, drawn to a method of operating an internal combustion engine, classified in class 123, subclass 1+.

Applicants elect, with traverse, the subject matter of the claims of Group I, i.e., Claims 1-14, for examination in this application. Applicants respectfully request that the Examiner withdraw, or at the very least modify, the requirement for restriction and provide an action on the merits of the nonelected claims.

It is respectfully submitted that the requirement for restriction between the claims of Group I and Group II is improper and should be withdrawn.

Restriction is proper only if the claims are either independent or patentably distinct and the search and examination of the entire application would impose a serious burden on the examiner (MPEP § 803). Applicants respectfully traverse the restriction requirement because the Examiner has not provided sufficient reasons to show that such a burden exists. It is the Examiner's apparent belief that that the product as claimed can be used in a materially different method, i.e., as a lubricant for door hinges, than the method as presently claimed, i.e., a method for operating an internal combustion engine. However, applicants respectfully disagree. Here, the claimed low phosphorous or phosphorous-free lubricating oil compositions contain at least

(a) a major amount of a base oil of lubricating viscosity and (b) a minor deposit-inhibiting effective amount of the recited polyol ester as an additive for the composition. As such, the claimed lubricating oil composition containing the minor deposit-inhibiting effective amount of the recited polyol ester additive would only be used in an engine to impart deposit protection in the engine. Certainly, one skilled in the art of lubricating oil compositions would not use a low phosphorous or phosphorous-free lubricating oil composition containing a minor deposit-inhibiting effective amount of an additive to impart deposit protection in an engine for lubricating a door hinge. On the contrary, one skilled in the art would simply use a base oil of lubricating viscosity to lubricate a door hinge. As all of applicants' claims are directed either to a lubricating oil composition (Claims 1-14); or to a method for operating an internal combustion engine employing the lubricating oil composition (Claims 15-28), applicants submit that the Examiner, in searching for the lubricating oil composition as claimed by applicants, would necessarily find art related to the lubricating oil composition (the claims of Group I) and the method for operating an internal combustion engine employing the lubricating oil composition (the claims of Group II).

Accordingly, applicants respectfully request that the Examiner withdraw, or at the very least modify, the requirement for restriction and provide an action on the merits of nonelected Claims 15-28.

Appln. No. 10/674,692

Response dated April 21, 2006

Response to Restriction Requirement dated March 24, 2006

For the foregoing reasons, applicants respectfully submit that all of the claims of the application as presented herein, including the nonelected claims, are in condition for examination on the merits. Early favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael E. Carmen", written in a cursive style.

Michael E. Carmen

Reg. No. 43,533

Attorney for Applicants

M. CARMEN & ASSOCIATES, PLLC  
170 Old Country Road – Suite 400  
Mineola, NY 11501  
Phone: (516) 992-1848  
Facsimile: (516) 739-0981  
MEC:bg